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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,559	12/14/2001	Tommy Petrogiannis	9680.188USU1	3770
23552	7590	04/14/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			POWERS, WILLIAM S	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/022,559	Applicant(s) PETROGIANNIS ET AL.	
	Examiner William S. Powers	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-36, 38-59 and 61-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-36, 38-59 and 61-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In light of Applicant's amendments, the previous objection to the drawings is withdrawn.

Claim Objections

1. Claim 68 is objected to because of the following informalities: In the Preliminary Amendment of 12/14/2001 claim 68 is amended to correct an improper dependency (claim 68 depends from claim 49 and NOT from claim 69). This is not reflected in the amended claims of 1/17/2006 as claim 68 is listed in its original form. Therefore, for purposes of examination, the Examiner assumes that claim 68 should read according to the changes made with the Preliminary Amendment.. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-2, 4-6, 8-12, 14-20, 22-27, 29-30, 32-36, 38-44, 46-50, 52-55 and 57-59, 61-68 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies).

As to claims 1 and 25, Smithies teaches:

- a. Having the user access the web environment from a secure electronic system, said secure system having verified the identity of the user (column 12, lines 28-54).
- b. Having the user sign the electronic document in said web environment, said signing being server-based (column 12, lines 14-16 and column 41, line 39-column 42, line 52) and comprising the substeps of:
 - i. Presenting the user with a web-based representation of the document (column 42, lines 8-24).
 - ii. Presenting the user with legal information related to said signing and getting agreement from the user of said legal information (column 34, lines 8-17).
 - iii. Upon agreement from the user of the legal information, applying said signature of the user on said document (column 29, lines 46-53).
- c. Generating a process log (transcript object) of the signing of step b), said process log providing for reconstruction of step b) as executed by said

user, and securely associating said process log with the document as signed (transcript object recreates the document and all actions during the signing procedure to the user for final approval of the signature and document) (column 42, lines 32-52).

d. Making the document as signed available to the user (column 40, lines 16-30).

As to claims 2 and 30, Smithies teaches retrieving said document from a document storing location (column 20, lines 55-63 and column 42, lines 8-30).

As to claims 4 and 32, Smithies teaches transforming said document from a non-web format to a web-format (column 20, line 55-column 21, line 7).

As to claims 5 and 26, Smithies teaches said legal information comprises information about legal implications of the signing of the document (column 34, lines 8-18).

As to claim 6 and 27, Smithies teaches said legal information comprises legal disclosures related to said document (column 13, lines 14-23 and column 22, lines 2-7).

As to claims 8 and 29, Smithies teaches presenting said legal information in a series of dialog boxes (column 34, lines 5-33 and figures 4a-g).

As to claims 9 and 33, Smithies teaches associating user-specific information to said document (column 12, lines 51-55 and column 33, lines 6-34).

As to claims 10 and 34, Smithies teaches said user-specific information is included in a special signature file defining the signature of the user (column 13, lines 42-46).

As to claims 11 and 35, Smithies teaches comprises associating a digital certificate (transcript object) (column 12, lines 32-38 and column 37, lines 25-33) and a private key to the document (column 8, lines 38-44).

As to claims 12 and 36, Smithies teaches obtaining said user-specific information from the secure electronic system (column 33, lines 6-34 and column 12, lines 51-54).

As to claims 14 and 38, Smithies teaches storing said process log (transcript object) in a log database (column 14, line 48-column 15, line 11).

As to claims 15 and 39, Smithies teaches:

- a. Generating a secure process authentication code (checksum) uniquely representing said process log (transcript object) (column 14, lines 22-39).
- b. Embedding said process authentication code (checksum) in said document as signed, thereby securely associating said process log (transcript object) and document (column 14, lines 5-21).

As to claims 16 and 40, Smithies teaches said secure process authentication code is a hash of said process log (column 14, lines 5-21).

As to claims 17 and 41, Smithies teaches providing an audit trail of the signing of step b) in the document as signed (column 28, line 46-column 29, line 67).

As to claims 18 and 42, Smithies teaches including a secure document authentication code uniquely representing said document as signed in said audit trail (column 14, lines 5-39).

As to claims 19 and 43, Smithies teaches storing said secure document authentication code in a database (column 14, line 48-column 15, line 11).

As to claims 20 and 44, Smithies teaches generating a hash of said document as signed defining the secure document authentication code (column 37, lines 9-24).

As to claims 22 and 46, Smithies teaches transmitting a copy of the document as signed to the user (column 21, lines 35-38).

As to claims 23 and 47, Smithies teaches enabling the user to download the document as signed (column 40, lines 16-30).

As to claims 24 and 48, Smithies teaches making the document as signed available to at least one additional party concerned by said electronic document (column 40, lines 16-30).

As to claim 49, Smithies teaches:

- a. Accessing means for accessing said web environment from a secure electronic system (column 12, lines 28-54).
- b. A document-rendering module for presenting the user with a web-based representation of said document (column 42, lines 8-24).
- c. A legal disclosure module for presenting the user, in said web environment, with legal information related to electronically signing said document and obtaining agreement from the user of said legal information (column 34, lines 8-17).

- d. A document approval module for providing the signature of the user to the document upon agreement from the user of the legal information, thereby signing said document (column 29, lines 46-53).
- e. A process log module for generating a process log of the signing of the document and securely associating said process log with the document as signed (transcript object recreates the document and all actions during the signing procedure to the user for final approval of the signature and document) (column 42, lines 32-52).
- f. Presenting the user with said web-based representation of the document (column 42, lines 8-24).
- g. Presenting the user with said legal information (column 34, lines 8-17).
- h. Obtaining agreement from the user of said legal information and of said signing of the document (column 29, lines 46-53).
- i. A document distribution module for making the document as signed available to the user, wherein said accessing means and said document-rendering, legal disclosure, document approval, process log and document distribution modules are server-based (column 40, lines 16-30).

As to claim 50, Smithies teaches said document-rendering module comprises retrieving means for retrieving said document from a document storing location (column 20, lines 55-63 and column 42, lines 8-30).

As to claim 52, Smithies teaches transforming means for transforming said document from a non-web format to a web-format (column 20, line 55-column 21, line 7).

As to claim 53, Smithies teaches said legal information comprises information about legal implications of the signing of the document (column 34, lines 8-18).

As to claim 54, Smithies teaches said legal information comprises legal disclosures related to said document (column 13, lines 14-23 and column 22, lines 2-7).

As to claim 55, Smithies teaches said legal disclosure module comprises displaying means for displaying (column 19, lines 39-43) said legal information (column 24, lines 63-67) in a web-based medium (column 12, lines 14-16).

As to claim 57, Smithies teaches said web-based medium includes a plurality of dialogue boxes (column 34, lines 5-33 and figures 4a-g).

As to claim 58, Smithies teaches:

- a. A user binding module cooperating with the secure electronic system to obtain therefrom user-specific information (column 12, lines 51-55 and column 33, lines 6-34).
- b. Generating a special signature file using said user-specific information (column 13, lines 42-46).
- c. Providing said special signature file to the document approval module, said special signature file defining the signature of the user (column 13, lines 42-46).

As to claim 59, Smithies teaches said user-specific information comprises a digital certificate (transcript object) (column 12, lines 32-38 and column 37, lines 25-33) and private key (column 8, lines 38-44).

As to claim 61, Smithies teaches:

- a. Said process log module comprises means for generating a secure process authentication code (checksum) uniquely representing said process log (transcript object) (column 14, lines 22-39).
- b. Embedding said secure process authentication code (checksum) in said document as signed, thereby securely associating said process log (transcript object) and document (column 14, lines 5-21).

As to claim 62, Smithies teaches means to generate a secure process authentication code comprise a hash module (column 14, lines 5-21).

As to claim 63, Smithies teaches an audit trail module for providing an audit trail of the signing of the document in said document as signed (column 28, line 46-column 29, line 67).

As to claim 64, Smithies teaches said audit trail includes a secure document authentication code uniquely representing said document as signed (column 14, lines 5-39).

As to claim 65, Smithies teaches the document authentication code is a hash of said document as signed (column 37, lines 9-24).

As to claim 66, Smithies teaches embedding a document authentication code uniquely representing the document as signed inside said document (column 14, lines 5-21).

As to claim 67, Smithies teaches transmitting a copy of the document as signed to the user (column 21, lines 35-38).

As to claim 68, Smithies teaches provides a copy of the document as signed to at least one additional party concerned by said electronic document (column 40, lines 16-30).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
7. Claims 3, 31 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) as applied to claim 1 and claim 25 and claim 49, respectively above, in view of US Patent No. 5,649,186 to Ferguson.

As to claims 3 and 31, Smithies does not expressly mention the use of templates in the generation of documents. However, in an analogous art, Ferguson teaches generating said document from a template (column 2, lines 52-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic signing scheme of Smithies

with the use of templates to generate documents of Ferguson in order to display them in a standardized way (HTML) as suggested by Ferguson (column 2, lines 52-60).

As to claim 51, Smithies teaches a document customization module cooperating with the document-rendering module for generating said document from a template (column 2, lines 52-60).

8. Claims 7, 28 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) as applied to claim 1 and claim 25 and claim 49, respectively above, and further in view of US Patent No. 6,151,624 to Teare et al. (hereinafter Teare).

As to claims 7, 28, Smithies teaches displaying the legal information concerning the signing of a document (column 34, lines 8-18), but does not expressly state that the legal information is displayed as a web page. However, in an analogous art, Teare teaches presenting said legal information in a series of web pages (column 16, lines 16-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic signing scheme of Smithies with the presentation of the legal information associated with the signing as a web

page of Teare so that the user can accept or decline the legal agreement over the internet as suggested by Teare (column 16, lines 16-27).

As to claim 56, Teare said web-based medium includes a plurality of web pages (column 16, lines 16-27).

9. Claims 21 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) as applied to claim 1 and claim 25, respectively above, and further in view of US Patent No. 5,646,997 to Barton.

As to claims 21 and 45, Smithies teaches saving the transcript object (column 44, lines 2-8), using a one-way hash created by the transcript generator module (column 14, lines 10-13) and embedding in the transcript object to authenticate signed document(s) and protect them from alteration (column 14, lines 5-21), but does not expressly state that the hash is embedded in the document. However, in an analogous art, Barton teaches embedding a secure document authentication code uniquely representing the document as signed inside said document (column 6, line 50-column 7, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic signing scheme of Smithies with the embedding of a secure document authentication code of Barton in order to "allow a user

to determine whether the digital data [has] been modified” as suggested by Barton (column 1, lines 11-12).

Response to Arguments

10. Applicant's arguments filed 1/17/2006 have been fully considered but they are not persuasive. Applicant's argument to the rejection of claims 1, 25 and 49 that although Smithies “provide for the signing of electronic documents, all of the actions leading to this signing take place on the user's own computer system, which requires the user to install special software” (Applicant's Remarks, page 16, lines 20-22). Applicant is directed to column 12, lines 14-16 of the Smithies patent which states, “[t]he client application **12** may also be an application that enables affirming parties to execute transactions across networks such as the Internet.” Applicant is further directed to column 41, line 39 to column 44, line 18 which is an embodiment of the invention that is based on a web server and operates in the same way as the Applicant's invention. For these at least these reasons, it is clear that Smithies anticipates the server-based signing environment of the Applicant.

Applicant's argument to the rejection of claims 13, 37 and 60 (now incorporated in claims 1, 25 and 49) that, “the transcript object of Smithies does not allow the reconstruction of the signing of an electronic document as executed by the user, including a reconstruction of the presentation of a web-based representation of the document to the user” (Applicant's Remarks, page 17, lines 17-20), Applicant is directed

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to web-based embodiment (column 41, line 39 to column 44, line 18) mentioned above. The Applicant is specifically directed to column 42, lines 32-52. The transcript generator module replays the content of the transcript object to the user in order to get an affirmation of all the actions that the user has taken with the document, including the signature, before the document becomes legally binding. For at least these reasons, it is clear that Smithies overcomes the argument presented by the Applicant.

Applicant's argument that, "Smithies does not teach or suggest a secure association between the document and the stored process log" (Applicant's Remarks, page 18, lines 20-21) is not persuasive. It is unclear from the claim language what constitutes a secure association between the document and the stored process log. The term "secure association" is not found in the specification or the claims. The transcript object of Smithies is secured through the use of checksums and encryption (Abstract), thereby ensuring that any attempts to alter the transcript object will be detected.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571 272 6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William S. Powers
Examiner
Art Unit 2134